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AGENDA FOR TELEPHONE INTERVIEW
IN U.S. PAT. APP. SER. NO. 09/503,362

4/14/04

In the Final Rejection dated 25 Feb 04, there is only ground for rejection, the same ground used in the First Office Action dated 4 Sept 03, namely, that all the pending claims are anticipated under 35 USC §102(e) by *Gershman et al.* (US 6,401,085).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "arranged as in the claim" (*Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)). Thus, even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present.

We have shown, in our previous Amendment, that *Gershman et al.* does not teach every single element of independent Claims 1 and 8 (or 14, or 15, for that matter), as those elements are arranged in those claims.

The suggested single topic for the agenda of the Telephone Interview would be the fact that the Examiner's response to our argument was to simply assert that these elements are inherent in *Gershman et al.*, without providing any justification or reasoning as to why these elements are necessarily inherent. The insufficiency of the Examiner's response can be shown by merely reproducing our original argument, and the Examiner's response, as is done on the following page.

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AGENDA FOR TELEPHONE INTERVIEW IN U.S. PAT. APP. SER. NO. 09/503,362
(PAGE 2 OF 2)

Amendment filed 2 Dec 03 by applicant (page 9, lines 9-19):

..., the "interface module" recited in Claim 1 of the present application is comprised of three elements: (1) a "protocol stack", (2) a "user agent", and (3) a "signal generator". It is difficult to tell what the Examiner is citing in **Gershman** as teaching the protocol stack of Claim 1. Regardless, there is **no** "protocol stack" inside an "interface module", as required by Claim 1, in **Gershman**. Similarly, there is **no** "user agent" **nor** "signal generator" which comprise an "interface module", as recited in Claim 1, described in **Gershman**. More importantly, even if these three components were described in **Gershman** (and they are not), the Examiner would still have to show that the three components (i.e., the protocol stack, the user agent, and the signal generator) are described in **Gershman as parts of** "an interface module", as is recited in Claim 1. But this is impossible: there is no "interface module" comprised of a protocol stack, a user agent, and a signal generator described in **Gershman**.

Final Rejection mailed 25 Feb 04 from Examiner (page 3, line 20, to page 4, line 6; reproduced verbatim):

Applicant arguments (paper no. 6, page 9, lines 10+), that there is "no protocol stack" in side an "interface module" of Gershman '085 and "user agent" and "signal generator". Examiner respectfully disagrees. Gershman '085 (figs. 1 and 17) shows different terminals/access devices (PDA, Vehicle, Laptop, Telephone, Television and etc), that are using different protocol and communication/interface module 134 which inherently stack protocol for wireless communication with the terminals through the wireless network, and a "user agent" and "signal generator" is inherent and necessitated by the system of Gershman '085, in order for decoding the received data and converting the data into a signal to output and present the information to the user.

To the extent that the Examiner's "response" can be understood, the Examiner appears to be arguing that an interface module comprised of a protocol stack, a user agent, and a signal generator, is necessarily inherent in *Gershman et al.* However, the Examiner's explanation of how these elements are inherent is difficult to understand and lacks any specifics. Furthermore, to the extent that the Examiner's reasoning is understood, it is completely insufficient for a finding of inherency. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). It is respectfully submitted that the Examiner's paragraph above is not sufficient to establish inherency.

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